



IPW

PATENT
Customer No. 22,852
Attorney Docket No. 8842.0001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
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Dung-Fang LEE, et al.)	Group Art Unit: 1632
)	
Application No.: 10/614,282)	Examiner: Robert M. Kelly
)	
Filed: July 8, 2003)	Confirmation No.: 2568
)	
For: INTERNAL RIBOSOME ENTRY)	
SITE OF THE LABIAL GENE)	
FOR PROTEIN EXPRESSION)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated September 22, 2004, the Office required
restriction under 35 U.S.C. § 121 between the following groups:

- Group I: Claims 1-16 and 20-35, drawn to nucleic acid vectors, host cells comprising the vectors, and method of making the vectors, in class 536, subclass 23.1;
- Group II: Claims 17-19, drawn to a method of expressing at least two cistrons, in class 435, subclass 320.1; and
- Group III: Claims 36-39, drawn to a method of treating a patient, in class 514, subclass 44.

Applicants provisionally elect to prosecute Group I, claims 1-16 and 20-35, with traverse. Applicants further provisionally elect the species baculovirus.

According to MPEP § 803, there are two requirements that must be met before a proper restriction requirement may be made: (1) the inventions must be independent or

distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicants respectfully submit that the Office has failed to establish the second requirement set forth in MPEP § 803.

In the present invention, Group I is directed to a nucleic acid vector, host cell comprising the vector, and method of making the vector. Group II is directed to a method for expressing at least two cistrons comprising introducing into a host cell a nucleic acid vector as defined in Group I. Additionally, Group III is directed to method of treating a patient by introducing a vector as defined in Group I. Contrary to the Office's contention that the multiple uses "require different structural and functional considerations," the structural element is the same between Groups I through III: the nucleic acid vector as defined in Group I. A search and examination of the subject matter of Group I would encompass a search for the subject matters of Groups II and III, and any additional search would not impose a serious burden upon the Examiner. It is therefore respectfully requested that the restriction requirement be reconsidered and withdrawn.

In the event that the Office maintains the restriction requirement, Groups II and III should be eligible for rejoinder when a product claim of Group I is found allowable and if the process claims of Groups II and III include all the limitations of the allowable product claim. MPEP § 821.04. Moreover, Applicants reserve the right to file divisional applications on the nonelected inventions if they are not rejoined.


The undersigned has been given limited recognition under 37 C.F.R. § 10.9(b) to prosecute this patent application. A copy of the document granting limited recognition is enclosed herewith.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 18, 2004

By: 
Yuko Soneoka
Limited Recognition under
37 C.F.R. § 10.9(b)